

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Klaus BOSSLET et al.

Examiner: Elli Peselev

Serial No.: 10/728,098

Group Art Unit: 1623

Filed: December 5, 2003

Confirmation No.: 7295

Title: EFFECTOR CONJUGATES, METHODS FOR THEIR PREPARATION AND
THEIR PHARMACEUTICAL

PETITION UNDER 37 C.F.R. § 1.183
REQUESTING DELAYED ACCEPTANCE OF THE APPLICATION TO ADJUST FOR
PATENT TERM UNDER 37 C.F.R. § 1.705(b).

Mail Stop : Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition under 37 C.F.R. § 1.183 to request delayed acceptance of an Application for Patent Term Adjustment pursuant to 37 C.F.R. § 1.705(b) in which Applicants' request adjustment of the patent term indicated in the Notice of Allowance mailed on 17 December 2008.

The Patent Term Adjustment request is being filed one day after the payment of the issue fee and is therefore untimely filed under 37 C.F.R. § 1.705(b). The issue fee was scheduled to be paid today, 17 March 2009. It is counsel's normal practice to pay issue fees the day before the due date. In this application, however, the applicants had inquired about the possibility for reconsideration of PTA, and undersigned's staff, unaware of the possibility that Applicants might decide to file an Application for Patent Term Adjustment, inadvertently paid the issue fee one-day early on 16 March 2009. Undersigned counsel failed to recall the possibility that a request for reconsideration might be filed when signing the issue fee

transmittal on March 16. The following day (today), March 17, the actual due date of the issue fee, applicants instructed counsel to request PTA reconsideration.

Thus, in the interests of justice, it is urged that the USPTO accept the one day late delayed application for Patent Term Adjustment and waive the rule that the application be filed before the issue fee payment. Had Applicants not inadvertently paid the issue fee one day early, an application for Patent Term Adjustment would have been timely filed.

In summary, in the interest of justice, Applicant's respectfully request that the Commissioner waive for one day the regulation under 37 C.F.R. § 1.705(b) that requests for term adjustment be filed before the payment of the issue fee.

Pursuant to 37 CFR 1.117(h) the required \$130 fee is being paid herewith, via the USPTO's electronic filing system (by authorization to charge such fee to Applicant's Deposit Account No. 13-3402).

Accordingly, Applicants respectfully request that the application to adjust the PTA specified in the Notice of Allowance be considered.

The Commissioner is hereby authorized to charge any additional fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Harry Shubin/

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Attorney Docket No.: **DORRIE-0007**
Date: **17 March 2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Klaus BOSSLET et al.

Examiner: Elli Peselev

Serial No.: 10/728,098

Group Art Unit: 1623

Filed: December 5, 2003

Confirmation No.: 7295

Title: EFFECTOR CONJUGATES, METHODS FOR THEIR PREPARATION AND
THEIR PHARMACEUTICAL

APPLICATION FOR PATENT TERM ADJUSTMENT

Mail Stop
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for reconsideration of the patent term adjustment indicated in the notice of allowance mailed on 17 December 2008, and is being filed as an application for patent term adjustment pursuant to 37 C.F.R. § 1.705(b). This request is being filed on the issue fee due date but one day after payment of the issue fee, and therefore this request is untimely filed under 37 C.F.R. § 1.705(b). This request is being filed along with a petition to waive the rule and accept the untimely filed application for patent term adjustment.

Pursuant to 37 C.F.R. § 1.705(b)(1) the required fee of \$200.00 set forth in 37 C.F.R. § 1.18(e) is being paid herewith, via the USPTO's electronic filing system (by authorization to charge such fee to Applicant's Deposit Account No. 13-3402).

Pursuant to 37 C.F.R. § 1.705(b)(2)(i), below is an indication of the correct patent term adjustment and the basis or bases under § 1.702 for the adjustment:

Correct Patent Term Adjustment (PTA) = 513 days

Bases for the above PTA

(A) 383 days under 37 C.F.R §§ 1.702(a)(1) and 1.703(a)(1);

plus

(B) 362 days under 37 C.F.R §§ 1.702(b) and 1.703(b);

minus

(C) 232 days under 37 C.F.R § 1.704(b) (applicant delays);

Total PTA = (A) 383 days + (B) 362 days - (C) 232 days = 513 days

Pursuant to 37 C.F.R. § 1.705(b)(2)(ii), below is an indication of the relevant dates specified in 37 C.F.R. § 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. § 1.703 (f) to which the patent is entitled:

(A) 383 days under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1)

The 383 days under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1) is calculated based on the following dates:

(1) The day after the date that is 14 months after the date on which the application was filed under 35 U.S.C. 111(a) = 5 February 2005

(2) The date of mailing of the first action under 35 U.S.C. 132 = 23 February 2006

(3) The number of days beginning on 5 February 2005 and ending on 23 February 2006 = 383 days

(B) 363 days under 37 C.F.R. §§ 1.702(b) and 1.703(b)

The 363 days under 37 C.F.R. §§ 1.702(b) and 1.703(b) is calculated based on the following dates:

(1) The day after the date that is 3 years after the date on which the application was filed under 35 U.S.C. 111(a) = 5 December 2006

(2) The date a Request for Continued Examination was filed = 3 December 2007

(3) The number of days beginning on 5 December 2006 and ending on 3 December 2007 = 363 days

The PTA specified in 37 C.F.R. § 1.703(f) to which the patent is entitled

As specified in 37 C.F.R. § 1.703(f), the term of a patent entitled to adjustment under §§ 1.702 and 1.703 shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of § 1.703, to the extent such periods are not overlapping, less the sum of the periods calculated under § 1.704.

For the instant application the sum of the periods under paragraphs (a) through (e) of § 1.703 is 746 days, calculated as follows:

- (A) 383 days delay under 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1);
plus
(B) 363 days delay under 37 C.F.R. §§ 1.702(b) and 1.703(b);

The two periods of delay specified above are not overlapping, since the first period of delay under 37 C.F.R. § 1.703(a)(1) ended on 23 February 2006 (when the first office action was mailed) and the second period of delay under 37 C.F.R. § 1.703(b) did not start until 5 December 2006 (the day after the date that is 3 years after the date on which the application

was filed). Thus, there were no days falling within both periods of delay and therefore no overlap¹.

For the instant application the sum of the periods calculated under 37 C.F.R. § 1.704 is 232 days, as follows:

C) With regards to the PTO calculations under § 1.704 (b), an Office Action was issued on 5 May 2006, to which a response was not filed until 7 August 2006. The PTO has inadvertently calculated this as 2 days beyond the 3 month period specified in § 1.704(b) - thus, a 2-day reduction. However, the three-month due date fell on a 5 August 2006 which was a Saturday and 7 August 2006 fell on a Monday and was thus timely filed. No extensions of time were necessary and Applicant's did not cause a delay in prosecution. Thus, the PTO calculated delay of 2 days is incorrect.

31 days under 37 C.F.R. § 1.704(b): An Office Action was issued on 26 September 2006, to which a response was not filed until 26 January 2007 2007, which was 31 days beyond the 3 month period specified in § 1.704(b) - thus, a 31 day reduction
and

61 days under 37 C.F.R. § 1.704(b): An Office Action was issued on 16 March 2007, to which a Notice of Appeal was not filed until 16 August 2007, which was 61 days beyond the 3-month period specified in § 1.704(b) - thus, a 61 day reduction
and

48 days under 37 C.F.R. § 1.704(c)(8): An Appeal Brief was timely filed on 16 October 2007, however a Supplemental Information disclosure was not filed until 3 December 2007, which was a 48 day delay, thus, a 48 day reduction
and

92 days under 37 C.F.R. § 1.704(b): An Office Action was issued on 17 March 2008, to which a response was not filed until 17 September 2008, which was 92 days beyond the 3 month period specified in § 1.704(b) - thus, a 92 day reduction.

¹ See Wyeth v. Dudas, 580 F.Supp.2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008)

The total reduction under 37 C.F.R. § 1.704(b) is :

31 days + 61 days + 48 days + 92 days = 232 days

Therefore, the PTA specified in 37 C.F.R. § 1.703(f) to which the patent is entitled is 514 days, calculated as follows:

746 days (the sum of the periods under paragraphs (a) through (e) of § 1.703)

minus

232 days (the sum of the periods calculated under § 1.704)

= 514 days

With respect to 37 C.F.R. § 1.705(b)(2)(iii), the resulting patent issued on the instant application is not subject to a terminal disclaimer.

Accordingly, Applicants respectfully request that the PTA specified in the notice of allowance (stated therein to be 179 days) be corrected to 514 days for the reasons as outlined above.

The Commissioner is hereby authorized to charge any additional fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Harry Shubin/

Harry Shubin, Registration # 32,004
Attorney for Applicant(s)

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Attorney Docket No. **Dorrie-0007**

Date: **March 17, 2009**

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